

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 38

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SAMUEL BOGOCH

Appeal No. 1997-2363
Application No. 08/031,562

ON BRIEF

MAILED

NOV 28 2001

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before WILLIAM F. SMITH, SPIEGEL, and GRIMES, Administrative Patent Judges.
GRIMES, Administrative Patent Judge.

REQUEST FOR RECONSIDERATION

Appellant requests reconsideration of the board's decision entered November 30, 2000, wherein the examiner's rejection of claims 1 and 2 under 35 U.S.C. § 112, first paragraph, was affirmed. Appellant asserts that the board "overlooked evidence of record" which supports his position that the claims are enabled and "misapprehended the meaning of the terms 'vaccine' and 'to inhibit clinical cancer' as used in the claims on appeal."

To the extent that Appellant urges that the board overlooked relevant evidence in the record, we disagree. The "overlooked evidence" cited by Appellant consists of

abstracts from a symposium which was held October 3-5, 1994. See the Request for Reconsideration, pages 2-4. These abstracts were not overlooked. In fact, they were expressly discussed in footnote 2 of the decision entered November 30, 2000, which states:

Appellant also submitted several abstracts, published after the filing date of the instant application, which he characterizes as showing that other peptide tumor antigens have shown positive results in vivo. See the Appeal Brief, page 3. However, enablement is determined as of the filing date of the application. See In re Glass, 492 F.2d 1228, 1232, 181 USPQ 31, 34 (CCPA 1974). Appellant has not explained how the submitted abstracts, which were published in 1994, show enablement of the claimed invention as of March 16, 1993, the filing date of the instant application. We therefore decline to consider the abstracts.

Thus, as the decision itself makes clear, we noted the abstracts but declined to consider them because they were published more than a year after the application's filing date, the relevant date for which enablement must be shown.

Appellant also asserts that the board "misapprehended the meaning of the terms 'vaccine' and 'to inhibit clinical cancer' as used in the claims on appeal." As we understand it, Appellant's argument on this point is that the claims encompass methods of both preventing development of cancer and treating cancer that has already developed, and therefore the claims should be considered to be enabled based on disclosed data which, he asserts, show that the claimed method and composition inhibit cancer cell growth.

This argument is also unpersuasive. First, we did not construe the claims to be limited to prevention of cancer, and to exclude treatment of developed cancer. Our

interpretation of the claims, and our enablement analysis, took into account the full scope of the claims. See the decision of November 30, 2000, page 8 ("The claims thus are directed to a product and method that protects the vaccinated patient from developing clinical cancer, derived from any cell type, and that is effective in treating developed clinical cancer, derived from any cell type. To enable the full scope of the instant claims, therefore, the specification must teach those of skill in the art how to prevent or treat clinical cancer, derived from any cell type, by administering anti-Recognin."); page 9 ("The claims are extremely broad in scope, and read on the prevention or treatment of any type of cancer by administration of malignin." (emphasis in original)); and page 10 ("[O]n balance, the Wands factors compel a conclusion that the guidance provided by the specification would not have enabled a person of skill in the art to practice the full scope of the claimed invention—i.e., to use anti-Recognin antibodies to prevent or treat any type of cancer—without undue experimentation." (emphasis in original)).

Finally, Appellant asserts that the disclosed data show that anti-Recognin kills cancer cells in vivo (or at least stops them from growing further). See the Request for Reconsideration, page 6. This argument is also unpersuasive. Appellant points to no specific record evidence to support his position. We have reviewed the glioma cell data that were discussed in the decision of November 30, 2000.¹ The data are found under

¹ The data are found in following reference: Bogoch et al., "Malignin, anti-malignin antibody, and Scantag," *Protides of the Biological Fluids*, Proc. of the 30th Colloquium, H. Peeters (ed.), Pergamon Press, New York, pp. 337-352 (1982). This reference was made of record by Appellant after it was cited

the heading "In vivo detection of cancer cells with radioisotope signal from Scantag."

Page 347 (emphasis added).² The radioimmunoassay is described as follows:

Wistar rats were injected intracerebrally with C₆ glioma tumor cells. . . . The rats were observed for the first signs of growing tumor. . . . As soon as symptoms appeared, the animals were injected with labeled SCANTAG intravenously in the tail vein, then the animal was sacrificed at varying times, the brain removed, the tumor dissected from normal brain, and the radioactivity in each dissected specimen compared.

Page 349. The authors concluded that "[t]he preferential localization with ^{99m}Tc-SCANTAG of radioactivity in tumor as compared to normal tissue is demonstrated." Id. Thus, although the reference discloses that the Scantag antibodies bound to tumor cells in vivo, no assays were done to determine whether the bound antibodies had any effect on the tumor cells to which they bound. There is simply nothing in these data to show that anti-Recognin antibodies kill or inhibit the growth of tumor cells.

We have carefully reviewed the original opinion in light of Appellant's request, but we find no point of law or fact which we overlooked or misapprehended in arriving at our decision. Therefore, Appellant's request has been granted to the extent that the decision has been reconsidered, but the request is denied with respect to making any

in the Appeal Brief and the examiner requested that a copy of the reference be submitted. See Paper No. 28 (mailed December 13, 1995).

² "Scantag" simply refers to radiolabeled anti-malignin antibody. See id., first paragraph under the "In vivo detection . . ." heading ("The feasibility of attaching a radioactive label to Anti-malignin antibody has been demonstrated. The injection into animals of this radio-labeled antibody, called SCANTAG, has been accomplished.").

Appeal No. 1997-2363
Application No. 08/031,562

modifications to the decision affirming the examiner's rejection under 35 U.S.C. § 112,
first paragraph.

No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136(a).

REHEARING DENIED


WILLIAM F. SMITH

Administrative Patent Judge


CAROL A. SPIEGEL

Administrative Patent Judge


ERIC GRIMES

Administrative Patent Judge

)
)
)
) BOARD OF PATENT
)
) APPEALS AND
)
) INTERFERENCES
)
)

EG/dm

Appeal No. 1997-2363
Application No. 08/031,562

KENYON AND KENYON
1500 K STREET NW
SUITE 700
WASHINGTON, DC 20005